

Remarks

The Communication mailed April 2, 2004 asserts that the response filed January 27, 2004 is not fully responsive to the Office Action mailed December 16, 2003. The Communication asserts that the January 27 response “cancels all claims drawn to the elected invention (*i.e.*, SEQ ID NO:71) and replaces them with claims drawn to a [n]on-elected invention (SEQ ID NO:12,223).” The Communication states that Applicants must include at least one claim drawn to the originally elected invention to avoid abandonment of the application.

The pending claims do include at least one claim drawn to the originally elected invention, *i.e.*, independent claim 32. The restriction requirement mailed September 28, 2000 (Paper No. 5) divided the claims into five invention groups. In the response filed October 30, 2000, Applicants elected invention group V, claims 32-37, characterized in the restriction requirement as “drawn to collections of probes.” Paper No. 5 at page 1, line 12.

Independent claim 32 as originally filed was directed to “An array of probes on a solid support wherein at least one probe comprises at least 14 contiguous nucleotides of a NORF gene comprising a SAGE tag as shown in SEQ ID NOS:67-811.” During prosecution, claim 32 has been amended several times, and each amendment was entered. Claim 32 is still directed to an array of probes on a solid support, but claim 32 now recites that the at least one probe comprises at least 18 contiguous nucleotides of an open reading frame of one particular NORF gene, NORF 5. NORF 5 was originally recited in elected claim 34, which was dependent on claim 32 and which is now canceled.

In the amendment filed January 27, 2004, claim 32 was amended to recite “SEQ ID NO:12,223 (NORF 5)” rather than “SEQ ID NO:71 (NORF 5).” That amendment was made because the previous amendment to claim 32 filed October 1, 2003 inadvertently introduced an

error in the recited sequence identifier for NORF 5. Claim 32 as amended October 1, 2003 read as follows:

32. An array of probes on a solid support for detecting gene expression, wherein at least one probe comprises at least 18 contiguous nucleotides of SEQ ID NO:71 (NORF 5).

SEQ ID NO:71, however, is the sequence identifier for the SAGE tag that identified NORF 5, whereas the open reading frame of NORF 5 is shown in SEQ ID NO:12,223. The amendment filed January 27, 2004 merely corrected this inadvertent error so that claim 32 now recites the correct NORF 5 sequence identifier.

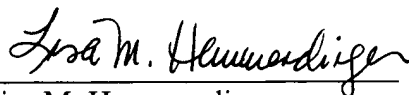
The amendment filed January 27, 2004 did not “cancel all claims drawn to the elected invention” as asserted in the Communication. The elected claims are directed to an array of probes on a solid support, as recited in originally filed and elected claim 32. Claim 32 still is directed to an array of probes on a solid support. The amendment filed January 27, 2004, which merely corrects the sequence identifier for NORF 5, does not change the subject matter of the originally elected invention. Thus, the pending claims include at least one claim drawn to the originally elected invention.

The response filed January 27, 2004 fully responds to the Office Action mailed December 16, 2003. Applicants respectfully request that the U.S. Patent and Trademark Office consider the substance of the response.

Respectfully submitted,
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Date: May 3, 2004

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